PATENT
Docket No.: NL000441
Customer No. 000022878

## REMARKS

By this amendment, claims 1-13 have been amended. Claims 1-13 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is respectfully requested.

**Rejection under 35 U.S.C. § 103**

Claim 1

Claim 1 recites an image-sensing display device comprising: an image display part including an image display panel and lighting means for illuminating the display panel; and an image-sensing part arranged on top of the display panel, the image-sensing part including a two-dimensional array of photosensitive elements, wherein the display panel includes a reflective display panel and wherein the lighting means include a front-lighting means, the front-lighting means arranged in front of the array of photosensitive elements on top of the reflective display panel.

Claims 1-13 were rejected under 35 U.S.C. § 103 as being anticipated by U.S. Patent No. 5,977,535 to Rostoker ("Rostoker") in view of U.S. Patent No. 6,196,692 to Umemoto et al ("Umemoto"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*



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It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Rostoker and Umemoto patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...* (Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Rostoker nor Umemoto teaches an image-sensing display device including a reflective image display panel, and a two-dimensional array of photosensitive elements on top of the reflective display panel, and a front-lighting means arranged in front of the array of photosensitive elements on top of the reflective display panel as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case the Rostoker reference, by providing back-lighting means to augment a visibility of an image on the LCD panel, is directed to a system in which the



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LCD panel is transmissive. Thus, this system clearly teaches away from the reflective display panel of claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**3. The references are not properly combinable if their intended function is destroyed**

It is clear that the Rostaker and Umemoto patents are not properly combinable since, if combined, their intended function is destroyed. More particularly, if the Rostaker patent were modified with the surface light source device, as required by the rejection, it would be rendered inoperable for its intended purpose because the transmissive LCD panel would not reflect light, and a visibility of an image on the LCD panel would be diminished instead of augmented.

Thus, since this modification of the Rostaker patent clearly destroys the purpose or function of the invention disclosed in the patent, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**4. The Combination of References is Improper**

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually



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exclusive, and compelling reason why the Rostoker and Umemoto patents cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Rostoker and Umemoto teaches, or even suggests, the desirability of the combination since neither teaches the specific arrangement and location of the reflective display panel, array of photosensitive elements, and front-lighting means as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.



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**Conclusion**

It is clear from all of the foregoing that independent claim 1 is in condition for allowance. Dependent claims 2-13 depend from and further limit independent claim 1 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings, therefore, no new matter is introduced.

An early formal notice of allowance of claims 1-13 is requested.

Respectfully submitted,

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